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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,068	12/11/2003	Oskar Pacher	0329-0049	7818

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EXAMINER	
ALEXANDER, MICHAEL P	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,068	PACHER ET AL.	
	Examiner	Art Unit	
	Michael P. Alexander	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *8-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/14/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim(s) 1-19 is/are pending.

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 20 September 2005 is acknowledged. The traversal is on the ground(s) that (1) Groups I and II are related, (2) no serous burden. This is not found persuasive because: (1) the Examiner admits the groups are related but they are related as intermediate and final products – the applicant has not disagreed with the Examiner's showing that the intermediate product is useful to make other than the final product and the applicant has not shown or admitted that Groups I and II are not patentably distinct, therefore the restriction must stand; and (2) separate classification is evidence of serious burden (see MPEP 808.02).

The requirement is still deemed proper and is therefore made FINAL.

Claims 8-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 20 September 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear from the claim language what elements are required and what elements are optional. Claims 2-7 are rejected in that they depend from claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Hiyashi (US 5,562,786), Nakai (US 5,458,703) or Toshimitsu (JP 2000-144334).

Regarding claims 1-2, Hiyashi teaches (col. 3 line 51 – col. 4 line 5), Nakai teaches (see claim 1) and Toshimitsu teaches (abstract) articles having amounts of C, Si, Mn, Mo, Cr, Ni, W and V, remainder iron and impurities, which overlap with the claimed ranges, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts

of each of the elements from the ranges disclosed by the cited references because the cited references teach the same utility throughout the disclosed ranges.

Still regarding claims 1-2, the alloys of the cited references would inherently be resistant to hydrogen embrittlement because the cited references teach substantially the same composition as the claimed invention. See MPEP 2112.01 I.

Regarding claims 3-4, It is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688. It would have been obvious to one of ordinary skill in the art to select amounts of molybdenum and tungsten in the claimed ratio from the ranges of molybdenum and tungsten disclosed by the cited references because the cited references teach the same utility throughout the disclosed ranges.

Regarding claims 5-7, the Examiner notes that the claims recite process steps, yet the claims are directed to an article not a process. Therefore, the Examiner will interpret the limitations as product-by-process limitations. See MPEP 2113. Hayashi teaches (col. 6 lines 61-69), Nakai teaches (col. 6 lines 14-24) and Toshimitsu teaches (0048) that the steel would hardened by quenching and tempering, which is substantially similar to the claimed process steps and would be expected to result in the same structure implied by the claimed process steps.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,869,692 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 5 of the patent teaches amounts of each of the elements which overlaps with the claimed elemental ranges, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of each of the claimed elements from the ranges disclosed by the patent because the patent teaches the same utility throughout the disclosed ranges.

Citation of Pertinent Prior Art

The prior art made of record is considered pertinent to applicant's disclosure. See Beguinot (US 5,972,129), Hiyashi (US 5,562,786), Nakai (US 5,458,703), Yoshimi (JP 2002-129201), Takaaki (JP 2002-294403), Toshimitsu (JP 2000-144334), Junji (JP 2003-268486), Maeda teaches (JP 11-179407), Toshinaga (JP 2003-239036), Kenji (JP 2003-200207), Seiji (JP 2001-123247), Kunio (JP 2001-293504), Yukio (JP 2000-202548), Keiichi (JP 200-192192), Tamiya (JP 11-106868), Kenichi (JP 09-194998), Hidesato (JP 08-193240), Kazushi (JP 07-150289), Masashi (JP 07-102342), Nobuhiro (JP 06-235046), Akira (JP 04-318148) or Masayuki (JP 06-041678). Beguinot teaches (col. 3 lines 20-43), Hiyashi teaches (col. 3 line 51 – col. 4 line 5), Nakai teaches (see claim 1), Yoshimi teaches (see claim 3), Takaaki teaches (see claim 3), Toshimitsu teaches (abstract), Junji teaches (see claim 1), Maeda teaches (JP 11-179407), Toshinaga teaches (see claims 1-2), Kenji teaches (see claims 1-7), Seiji teaches (abstract), Kunio teaches (abstract), Yukio teaches (abstract), Keiichi teaches (abstract), Tamiya teaches (abstract), Kenichi teaches (abstract), Hidesato teaches (abstract), Kazushi teaches (abstract), Masashi teaches (abstract), Nobuhiro teaches (abstract), Akira teaches (abstract), and Masayuki teaches (abstract) articles having amounts of C, Si, Mn, Mo, Cr, Ni, W and V, remainder iron and impurities, which overlap with the claimed ranges.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mpa

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